

Amendment and Response

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Serial No.: 09/553,683

Confirmation No.: 6497

Filed: 21 April 2000

For: SURGICAL TARGETING SYSTEM**Remarks**

The Office Action mailed 30 July 2003 has been received and reviewed. Claim 64 has been amended, leaving claims 28-66 pending. Reconsideration and withdrawal of the rejections are respectfully requested.

Allowable Claims

Applicant notes that claims 28 and 29 have been indicated as allowable.

Amended Claim 64

Applicant has amended claim 64 to correct a typographical error discovered during preparation of this response. Applicant submits that the amendment is cosmetic in nature only and does not constitute a narrowing of the scope of claim 64 in any respect.

The 35 U.S.C. §103 Rejections

Claims 30-38, 41-43, 47-49, and 53-61 were rejected under 35 U.S.C. §103(a) as being unpatentable over Muller (U.S. Patent No. 4,899,762) in view of Krupnick (U.S. Patent No. 5,052,035).

Applicant traverses this rejection and submits that claims 30-38, 41-43, 47-49, and 53-61 are not *prima facie* obvious over Muller in view of Krupnick for at least the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

Claims 30-38, 41-43, 47-49, and 53-61 are not *prima facie* obvious because the combination of Muller and Krupnick does not teach all of the features recited in those claims.

With respect to independent claims 30, 47, 53, 57, and 61, neither Muller or Krupnick

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teach or suggest that "each radio-opaque label of the plurality of radio-opaque labels is located at one intersection of the plurality of intersections in the radio-opaque pattern to provide a plurality of labeled intersections on the surgical drape" as recited in each of these independent claims.

One example of such an arrangement is depicted in, e.g., Figure 1 of the present application. In contrast, Muller and Krupnick both teach that labels are limited to the perimeter of the patterns formed on the sheets. For example, in Figure 1 of both Muller and Krupnick illustrate this point, i.e., all of the labels are located at the perimeters of the radio-opaque patterns. Significantly, neither Muller or Krupnick teach or suggest that individual intersections be labeled.

As a result, the combination of Muller and Krupnick does not support a *prima facie* case of obviousness with respect to independent claims 30, 47, 53, 57, and 61, or any of their respective dependent claims listed in this rejection.

With respect to independent claim 53 and dependent claims 43 and 49, Applicant notes that the combination of Muller and Krupnick also do not teach or suggest "a central cutout and a slit extending outward from the central cutout" as recited in these claims.

It is asserted in the Office Action that "Krupnick 035 also teaches a cutout through the grid lines to effectuate a biopsy (see Figure 2 and see col. 5, lines 17-31)." *Office Action*, p. 3, lines 1-2. Applicant notes, however, that the teachings of Krupnick are limited to die cut lines. No cutout is provided in the surgical drape as recited in claims 43, 49, and 53. Also, with no cutout, Krupnick cannot teach "a slit extending outward" from a central cutout as recited in claims 43, 49, and 53.

Furthermore, many of the dependent claims recite features that are not addressed in the Office Action. More significantly, these features are not taught or suggested by either Muller or Krupnick. Examples include the feature recited in dependent claim 41 ("lines of different shapes" - *see, e.g.*, Specification, p. 19, lines 3-9); dependent claims 42 & 48 ("the radio-opaque pattern comprises a plurality of quadrants defined by four labeled intersections of the plurality of labeled intersections" - *see, e.g.*, Figures 1 & 3); etc.

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In view of the above, Applicant respectfully submits that claims 30-38, 41-43, 47-49, and 53-61 are not *prima facie* obvious over Muller in view of Krupnick. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

Claims 39-40, 44-46, 50-52, and 62-66 were rejected under 35 U.S.C. §103(a) as being unpatentable over Muller (U.S. Patent No. 4,899,762) in view of Krupnick (U.S. Patent No. 5,052,035) and Mosby (U.S. Patent No. 5,260,985).

Applicant traverses this rejection and submits that claims 39-40, 44-46, 50-52, and 62-66 are not *prima facie* obvious over Muller in view of Krupnick and Mosby for at least the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

Claims 39-40, 44-46, 50-52, and 62-66 are not *prima facie* obvious because the combination of Muller, Krupnick and Mosby does not teach all of the features recited in those claims.

All of claims 39-40, 44-46, and 50-52 depend from one of the independent claims discussed above with respect to the rejection based on only Muller and Krupnick. The addition of Mosby does not address any of the deficiencies of Muller and Krupnick as applied to those independent claims. For that reason alone, Applicant respectfully submits that claims 39-40, 44-46, and 50-52 are patentable over the combination of Muller in view of Krupnick and Mosby.

With respect to dependent claims 44 & 50, Applicant further notes Mosby does not disclose or suggest "a slit extending outward from the central cutout" as recited in claims 43 and 49, from which claims 44 & 50 depend (respectively).

With respect to dependent claims 45, 46, 51, 52, Applicant notes that the combination of

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Muller in view of Krupnick and Mosby does not disclose or suggest "a cylindrical portion adapted to fit over a finger" as recited in claims 45 and 51. Nor does the combination of Muller in view of Krupnick and Mosby teach or suggest "a hemispherical end portion located at one end of the cylindrical portion" as recited in claims 46 and 52.

The rejection of claims 45, 46, 51 and 52 is premised on the assertion that the cited portions of Mosby teach "the use of radio-opaque circles and utilization of pliable material for use on breast procedures or on body parts resembling cylindrical or conical configurations such as a finger." *Office Action*, p. 3, lines 14-16. A careful review of Mosby (including the portions cited in support of this rejection portions), however, reveals that Mosby does not disclose or suggest that the adhesive sheet may be used on a finger. As a result, the rejection of claims 45, 46, 51, and 52 is not supported by the combination of Muller in view of Krupnick and Mosby.

With respect to independent method claims 62 & 64, Applicant submits that the combination of Muller in view of Krupnick and Mosby does not teach or suggest that "each radio-opaque label of the plurality of radio-opaque labels is located at one intersection of the plurality of intersections in the radio-opaque pattern to provide a plurality of labeled intersections on the surgical drape" as recited in each of these independent claims. One example of such an arrangement is depicted in, e.g., Figure 1 of the present application. In contrast, Muller and Krupnick both teach that labels are limited to the perimeter of the patterns formed on the sheets. For example, in Figure 1 of both Muller and Krupnick illustrate this point, i.e., all of the labels are located at the perimeters of the radio-opaque patterns. Significantly, neither Muller or Krupnick teach or suggest that individual intersections be labeled. Mosby does not teach any labels on the sheet material.

As a result, the combination of Muller in view of Krupnick and Mosby does not support a *prima facie* case of obviousness with respect to independent claims 62 and 64 or their respective independent claims 63, 65, and 66.

With respect to independent claim 62, Applicant notes that the combination of Muller in view of Krupnick and Mosby also do not teach or suggest "a central cutout and a slit extending outward from the central cutout" as recited in claim 62.

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With respect to independent claim 64, the combination of Muller in view of Krupnick and Mosby does not teach or suggest "unrolling a cylindrical portion of the surgical drape onto an extremity, finger or other appendage of the patient" as recited. In fact, the Office Action is silent as to where these actions are taught in the cited references or how they are rendered obvious in view of the cited references.

In view of the above, Applicant respectfully submits that claims 39-40, 44-46, 50-52, and 62-66 are not *prima facie* obvious over Muller in view of Krupnick and Mosby. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

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Summary

It is respectfully submitted that the pending claims 28-66 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
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01 DECEMBER 2003
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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 1st day of December, 2003, at 2:35 PM (Central Time).

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